

**REMARKS**

This is a full and timely response to the outstanding final office action dated June 3, 2009. Through this response, claims 75-78, 92, 94-95, and 97-99 have been amended, and claims 80-81 have been canceled without prejudice, waiver, or disclaimer. Reconsideration and allowance of the application and pending claims 75-79 and 82-99 are respectfully requested.

**I. Claim Rejections - 35 U.S.C. § 103(a)**

**A. Statement of the Rejection**

Claims 75-81, 83, 84, 92, 93, and 95-99 have been rejected under 35 U.S.C. § 103(a) as allegedly unpatentable over *Hoang* (U.S. Pat. No. 6,557,030) in view of *Kusaba et al.* ("*Kusaba*," U.S. Pat. No. 6,510,556), *Lett et al.* ("*Lett*," U.S. Patent No. 5,592,551), and *Hicks, III et al.* ("*Hicks*," U.S. Pat. Public. No. 20040261112).

Claim 82 has been rejected under 35 U.S.C. § 103(a) as allegedly unpatentable over *Hoang* in view of *Kusaba*, *Lett*, and *Hicks*, and further in view of *Okamoto et al.* ("*Okamoto*," U.S. Pat. No. 6,901,385).

Claims 85-87 have been rejected under 35 U.S.C. § 103(a) as allegedly unpatentable over *Hoang* in view of *Kusaba*, *Lett*, and *Hicks*, and further in view of *Ellis et al.* ("*Ellis*," U.S. Pat. Public. No. 20030188313).

Claims 88-90 have been rejected under 35 U.S.C. § 103(a) as allegedly unpatentable over *Hoang* in view of *Kusaba*, *Lett*, and *Hicks*, and further in view of *Hunter et al.* ("*Hunter*," U.S. Pat. Public. No. 20020056118).

Claim 91 has been rejected under 35 U.S.C. § 103(a) as allegedly unpatentable over *Hoang* in view of *Kusaba, Lett, and Hicks, and Hunter*, and further in view of *Philips* (U.S. Pat. Public. No. 20020069412) and *Tomita et al.* ("*Tomita*," U.S. Pat. No. 6,732,372).

Claim 94 has been rejected under 35 U.S.C. § 103(a) as allegedly unpatentable over *Hunter* in view of *Tomita*.

Applicants respectfully traverse these rejections to the extent not rendered moot by amendment, and believe the claims to be allowable over the art of record.

#### **B. Discussion of the Rejection**

The U.S. Patent and Trademark Office ("USPTO") has the burden under section 103 to establish a *prima facie* case of obviousness according to the factual inquiries expressed in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966). The four factual inquires, also expressed in MPEP 2100-116, are as follows:

- (A) Determining the scope and contents of the prior art;
- (B) Ascertaining the differences between the prior art and the claims in issue;
- (C) Resolving the level of ordinary skill in the pertinent art; and
- (D) Evaluating evidence of secondary considerations.

Applicants respectfully submit that a *prima facie* case of obviousness is not established using the art of record.

Claims 75-81, 83, 84, 92, 93, and 95-99 – Hoang, Kusaba, Lett and Hicks

**Independent Claim 75**

Claim 75 recites (with emphasis added):

75. A system comprising:

a digital home communication terminal (DHCT) configured to receive media content from a remote location over a network, the DHCT comprising:  
a hard disk drive;  
a memory having application software; and  
a processor configured with the application software to provide a first graphics user interface (GUI) comprising download options for the reception of purchasable and recordable media (PRM) content and a second GUI comprising plural media content choices for which the download options do and do not pertain, the PRM content comprising content that is purchased one-time for indefinite use, the processor further configured with the application software to request from the remote location a download of a first PRM content to the hard disk drive, ***the first PRM content selected by a user from the second GUI, the download independent of a playback rate for the first PRM content, the first GUI comprising plural user-selectable download rates for the first PRM content.***

Applicants respectfully submit that the amendments to claim 75 have rendered the rejection moot. Further, Applicants respectfully submit that independent claim 75 is allowable over *Hoang* in view of *Kusaba, Lett, and Hicks* for at least the reason that *Hoang* in view of *Kusaba, Lett, and Hicks* fails to disclose, teach, or suggest at least the above emphasized claim features. As set forth on page 7 of the final Office Action, *Hoang* is deficient on the download options, and refers to *Kusaba*, with emphasis on Figure 4 (e.g., 4C) and the picture plane 420. However, *Kusaba* does not disclose ***user-selectable download rates.***

Additionally, Applicants maintain that the combination of *Hoang* and *Kusaba* is not obvious. The final Office Action rebuts Applicants' previous argument on this issue, and alleges the following on page 3:

Both Hoang and Kusaba both disclose VOD systems that are able to offer the user the ability to demand video at a time the user wishes. Furthermore, Kusaba offers improvements to the conventional VOD systems (See Figs. 1-8; col. 1 lines 57-67). Therefore, one of ordinary skill in the art would find it advantageous to apply the teaches[sic] of Kusaba to a VOD system disclosed by Hoang in order to enhance the video on demand (VOD) system to make it more adaptable, smooth, and efficient thereby giving the user more control (See col. 1 lines 57-67).

Applicants respectfully disagree with the alleged motivation. The intelligence for the scheduling matrix resides at the server side in *Hoang* (e.g., see, col. 2 of *Hoang*), and *Hoang* is concerned with providing VOD to a large number of users (see, e.g., col. 3, lines 15-20, *Hoang*). *Kusaba*, on the other hand, is more focused on removing the control from a headend, as noted by the above col. 1, lines 57-67 citation to *Kusaba*. It makes no technical sense to off-load the manner in which VOD is delivered in *Hoang* to a client device. In other words, there is a conflict in system operational strategy and principle of operation between the two references that would more reasonably urge against their combination. As set forth according to well-established Federal case law:

If the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious. *In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959).

Applicants respectfully submit that the combination of *Hoang* and *Kusaba* is violative of the law set forth above, and for at least this additional reason, Applicants respectfully submit that claim 75 is allowable over at least the combination of *Hoang* and *Kusaba*.

The addition of *Lett* and *Hicks* does not remedy the deficiencies of *Hoang* and *Kusaba* at least with regard to the above-emphasized features. Indeed, there is no disclosure of a user-selectable rate of delivery of PPV or VOD content in either reference. Accordingly, Applicants respectfully submit that claim 75 is allowable over *Hoang* in view of

*Kusaba, Lett, and Hicks*, and respectfully request withdrawal of the rejection and allowance of the claim.

Because independent claim 75 is allowable over *Hoang* in view of *Kusaba, Lett, and Hicks*, dependent claims 76-79, 83, 84, and 95-96 are allowable as a matter of law for at least the reason that the dependent claims 76-79, 83, 84, and 95-96 contain all elements of their respective base claim. See, e.g., *In re Fine*, 837 F.2d 1071 (Fed. Cir. 1988).

Also, Applicants respectfully submit that one or more of the dependent claims are allowable on separate grounds, even beyond the fact that the rejections are rendered moot by amendment. For instance, with regard to claim 83, the final Office Action (page 10) alleges the following:

Regarding claim 83, wherein the first GUI further comprises a price window having a monetary value that varies depending on which of the selectable first (e.g. 3 days \$3.99) or second options (e.g. 1 week \$4.99) of the download option list is selected (See *Lett* Fig. 13).

Applicants respectfully disagree. Claim 83 requires the following (emphasis added):

...wherein the first GUI further comprises **a price window having a monetary value that varies** depending on which of the selectable first or second options of the download option list is selected.

Assuming *arguendo* the \$3.99 field in Figure 13 of *Lett* can be construed as the claimed **price window**, the 3.99 “price window” does not vary. Indeed, there is a second “price window” associated with the 1 week field (having a value of \$4.99). Accordingly, Applicants respectfully request that the rejection be withdrawn to claim 83 and the claim allowed.

As another example, the rejection to claim 84 (page 11) alleges disclosure of the claimed “non-channel identifier indicator” in Figures 5 and 6 and 13 of *Lett* (i.e., “PPV”). Applicants respectfully disagree. PPV is associated with the channel (e.g., the PPV

channel, not unlike the WATL channel located beneath it in Figure 6 of *Lett*), whereas the claim requires a “non-channel identifier” indicator. For at least this additional reason, Applicants respectfully request that the rejection be withdrawn to claim 84 and the claim allowed.

### Independent Claim 92

Claim 92 recites (with emphasis added):

92. A method, comprising:

providing a first graphics user interface (GUI) at a digital home communications terminal (DHCT), the first GUI comprising download options for the reception of purchasable and recordable media (PRM) content, ***the PRM content comprising content that is purchased one-time for indefinite use and downloadable at a playback-independent rate, the first GUI comprising plural user-selectable download rates for the PRM content;***

providing a second GUI at the DHCT, the second GUI comprising plural media content choices for which the download options do and do not pertain; and

***requesting a download of a first PRM content from a remote location to a hard disk drive coupled to the DHCT at one of the plural user-selectable download rates, the first PRM content selected by a user from the second GUI.***

Applicants respectfully submit that the amendments to claim 92 have rendered the rejection moot. Further, Applicants respectfully submit that independent claim 92 is allowable over *Hoang* in view of *Kusaba*, *Lett*, and *Hicks* for at least the reason that *Hoang* in view of *Kusaba*, *Lett*, and *Hicks* fails to disclose, teach, or suggest at least the above emphasized claim features. The final Office Action (page 11) refers to the rejection of claim 75 for application to the rejection of claim 92. As set forth on page 7 of the final Office Action, *Hoang* is deficient on the download options, and refers to *Kusaba*, with emphasis on Figure 4 (e.g., 4C) and the picture plane 420. However, *Kusaba* does not disclose ***user-selectable download rates.***

Additionally, Applicants maintain that the combination of *Hoang* and *Kusaba* is not obvious. The final Office Action rebuts Applicants' previous argument on this issue, and alleges the following on page 3:

Both *Hoang* and *Kusaba* both disclose VOD systems that are able to offer the user the ability to demand video at a time the user wishes. Furthermore, *Kusaba* offers improvements to the conventional VOD systems (See Figs. 1-8; col. 1 lines 57-67). Therefore, one of ordinary skill in the art would find it advantageous to apply the teachings[sic] of *Kusaba* to a VOD system disclosed by *Hoang* in order to enhance the video on demand (VOD) system to make it more adaptable, smooth, and efficient thereby giving the user more control (See col. 1 lines 57-67).

Applicants respectfully disagree with the alleged motivation. The intelligence for the scheduling matrix resides at the server side in *Hoang* (e.g., see, col. 2 of *Hoang*), and *Hoang* is concerned with providing VOD to a large number of users (see, e.g., col. 3, lines 15-20, *Hoang*). *Kusaba*, on the other hand, is more focused on removing the control from a headend, as noted by the above col. 1, lines 57-67 citation to *Kusaba*. It makes no technical sense to off-load the manner in which VOD is delivered in *Hoang* to a client device. In other words, there is a conflict in system operational strategy and principle of operation between the two references that would more reasonably urge against their combination. As set forth according to well-established Federal case law:

If the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious. *In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959).

Applicants respectfully submit that the combination of *Hoang* and *Kusaba* is violative of the law set forth above, and for at least this additional reason, Applicants respectfully submit that claim 92 is allowable over at least the combination of *Hoang* and *Kusaba*.

The addition of *Lett* and *Hicks* does not remedy the deficiencies of *Hoang* and *Kusaba* at least with regard to the above-emphasized features. Indeed, there is no

disclosure of a user-selectable rate of delivery of PPV or VOD content in either reference. Accordingly, Applicants respectfully submit that claim 92 is allowable over *Hoang* in view of *Kusaba*, *Lett*, and *Hicks*, and respectfully request withdrawal of the rejection and allowance of the claim.

Because independent claim 92 is allowable over *Hoang* in view of *Kusaba*, *Lett*, and *Hicks*, dependent claims 93 and 97-99 is allowable as a matter of law.

Also, Applicants respectfully submit that one or more of the dependent claims are allowable on separate grounds, even beyond the fact that the rejections are rendered moot by amendment. For instance, with regard to claim 93, the final Office Action refers to the rejection of claim 83, where that rejection (page 10) alleges the following:

Regarding claim 83, wherein the first GUI further comprises a price window having a monetary value that varies depending on which of the selectable first (e.g. 3 days \$3.99) or second options (e.g. 1 week \$4.99) of the download option list is selected (See *Lett* Fig. 13).

Applicants respectfully disagree. Claim 93 requires the following (emphasis added):

providing a plurality of download options and a **price window** in the second GUI, **a monetary value in the price window differing** depending on which of the plurality of download options are selected.

Assuming *arguendo* the \$3.99 field in Figure 13 of *Lett* can be construed as the claimed **price window**, the 3.99 “price window” does not vary. Indeed, there is a second “price window” associated with the 1 week field (having a value of \$4.99). Accordingly, Applicants respectfully request that the rejection be withdrawn to claim 93 and the claim allowed.

Claim 82- Hoang, Kusaba, Lett, Hicks, and Okamoto

The addition of *Okamoto* does not cure the deficiencies of *Hoang*, *Kusaba*, *Lett*, *Hicks* discussed above in connection with independent claims 75. Therefore, for at least

the reason that claim 75 is allowable over *Hoang, Kusaba, Lett, Hicks, and Okamoto*, dependent claim 82 is allowable as a matter of law. Therefore, Applicants respectfully request that the rejection of claim 82 be withdrawn.

In addition, Applicants respectfully submit that the combination involving *Okamoto* is not obvious. In addition to having a completely different US classification (e.g., 705) than the other combined references, the focus on copyright and digital rights management (see page 1, *Okamoto*) is completely different than the focus of the other references in the proposed combination, and addresses a completely different need than the other references (e.g., para. 0009, obviating the need to download content from the Internet). Indeed, the alleged motivation to include download option lists would appear to be contrary to the example need suggested in *Okamoto*. For at least this additional reason, Applicants respectfully request that the rejection be withdrawn and claim 82 allowed.

Claims 85-87 - *Hoang Kusaba, Lett, and Hicks, and Ellis*

The addition of *Ellis* does not cure the deficiencies of *Hoang, Kusaba, Lett, Hicks* discussed above in connection with independent claims 75. Therefore, for at least the reason that claim 75 is allowable over *Hoang, Kusaba, Lett, Hicks, and Ellis*, dependent claims 85-87 are allowable as a matter of law. Therefore, Applicants respectfully request that the rejection of claims 85-87 be withdrawn.

Applicants respectfully submit that one or more of the dependent claims are allowable on separate grounds, even beyond the fact that the rejections are rendered moot by amendment. For instance, with regard to claim 85, the final Office Action (page 4) alleges that *Ellis* discloses “that the user has access to a service guide menu (see Fig. 6) via a service guide option (see paragraphs 0133; access the MENU),” and that *Ellis*’s “electronic program guide system also includes browse and flip modes. All the features

(including the browse and flip modes) within the electronic program guide of *Ellis* are consider an interactive program guide (IPG).” Applicants respectfully disagree. Claim 85 requires plural “channels” and “titles” in its claimed IPG, whereas the flip and browse modes are not disclosed in *Ellis* as including plural channels and titles. Even assuming *arguendo* the menu of Figure 6 of *Ellis* is a service guide, since the flip and browse modes do not teach an IPG as claimed, access from the flip or browse modes does not meet the claim language, and accordingly, Applicants respectfully request that the rejection be withdrawn for this additional reason.

Additionally, it is not obvious to combine *Ellis*. *Ellis* (see, e.g., para. 224) uses an overnight courier for delivery of content, and hence download options for PRM content would fundamentally change the manner in which *Ellis* operates. For at least this additional reason, Applicants respectfully request that the rejection be withdrawn.

Claims 88-90 – Hoang, Kusaba, Lett, Hicks, and Hunter

The addition of *Hunter* does not cure the deficiencies of *Hoang, Kusaba, Lett, Hicks* discussed above in connection with independent claims 75. Therefore, for at least the reason that claim 75 is allowable over *Hoang, Kusaba, Lett, Hicks*, and *Hunter*, dependent claims 88-90 are allowable as a matter of law. Therefore, Applicants respectfully request that the rejection of claims 88-90 be withdrawn.

In addition, the addition of *Hunter* is not obvious. For instance, *Hunter* (see, e.g., para 0018) describes blanket transmission of pre-selected content, which from a technical standpoint, may obviate the need for any subscriber-side presentation or selection of download content. For at least this additional reason, Applicants respectfully request that the rejection be withdrawn and the claims allowed.

Claim 91 – Hoang, Kusaba, Lett, and Hicks, Hunter, Philips and Tomita

The addition of *Hunter, Philips* and *Tomita* does not cure the deficiencies of *Hoang, Kusaba, Lett, Hicks* discussed above in connection with independent claims 75. Therefore, for at least the reason that claim 75 is allowable over *Hoang, Kusaba, Lett, Hicks, Hunter, Philips* and *Tomita*, dependent claim 91 is allowable as a matter of law. Therefore, Applicants respectfully request that the rejection of claim 91 be withdrawn.

In addition, the addition of *Hunter* is not obvious. For instance, *Hunter* (see, e.g., para 0018) describes blanket transmission of pre-selected content, which from a technical standpoint, may obviate the need for any subscriber-side presentation or selection of download content. For at least this additional reason, Applicants respectfully request that the rejection be withdrawn and the claims allowed.

Claim 94 – Hunter and Tomita

Claim 94 recites (with emphasis added):

94. A system, comprising:
  - a storage device comprising one of a digital video disk (DVD) or compact disk (CD);
  - a tuner configured to receive broadcast and on-demand media content;
  - a memory with application software; and
  - a processor configured with application software to provide a graphics user interface (GUI) that enables a user to archive broadcast and on-demand media content downloaded to one of the DVD or CD, the broadcast and on-demand media content archived based on metadata associated with the broadcast and on-demand media content, the GUI **further configured to enable the user to enter a term-search for media content stored on the DVD or CD.**

Applicants respectfully submit that the rejection has been rendered moot. Further, Applicants respectfully submit that independent claim 94 is allowable over *Hunter* in view of *Tomita* for at least the reason that *Hunter* in view of *Tomita* fails to disclose, teach, or

suggest at least the above emphasized claim features. For at least these reasons, Applicants respectfully request that the rejection be withdrawn and claim 94 allowed.

**II. Canceled Claims**

As identified above, claims 80-81 have been canceled from the application through this Response without prejudice, waiver, or disclaimer. Applicants reserve the right to present these canceled claims, or variants thereof, in continuing applications to be filed subsequently.

**CONCLUSION**

Applicants respectfully submit that Applicants' pending claims are in condition for allowance. Any other statements in the Office Action that are not explicitly addressed herein are not intended to be admitted. In addition, any and all findings of inherency are traversed as not having been shown to be necessarily present. Furthermore, any and all findings of well-known art and official notice, and similarly interpreted statements, should not be considered well known since the Office Action does not include specific factual findings predicated on sound technical and scientific reasoning to support such conclusions. Favorable reconsideration and allowance of the present application and all pending claims are hereby courteously requested. If, in the opinion of the Examiner, a telephonic conference would expedite the examination of this matter, the Examiner is invited to call the undersigned attorney.

Respectfully submitted,

/David Rodack/

David Rodack  
Registration No. 47,034

Merchant & Gould P.C.  
P.O. Box 2903  
Minneapolis, MN 55402-0903  
404.954.5100